

## **REMARKS**

In the Office Action dated March 31, 2006, claims 1-14 were presented for examination. Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 6, and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by *Smith*, U.S. Patent No. 5,832,068. Claims 1, 5, 6, 9, and 13 were rejected under 35 U.S.C. §102(a) as being anticipated by *Applicant's Admitted Prior Art (AAPA)*. Claims 2-4, 7, 8, 10-12, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of *Applicant's Admitted Prior Art (AAPA)*.

The following remarks are provided in support of the pending claims and responsive to the Office Action of March 31, 2006 for the pending application.

### **I. Rejection of Claims 1-14 under 35 U.S.C. §112, second paragraph**

In the Office Action dated March 31, 2006, the Examiner assigned to the application rejected claims 1-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has listed several terms he found indefinite. Applicant is hereby responding to each item in the order presented by the Examiner.

With respect to claims 1 and 6, the Examiner has noted an issue with the term “compiling”. The word compiling is defined as “To put together or compose from materials gathered from several sources”<sup>1</sup>. Applicant’s invention compiles a single output stream from a plurality of input streams, as claimed. Upon reading the entire clause that pertains to the term

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<sup>1</sup>Dictionary.com, attached as Exhibit A.

“compiling” it is clear that the output stream is creating from data received from several input streams. Applicant has not amended the term compiling, as it is Applicant’s position that this term is not indefinite.

With respect to claims 1, 6, and 9, the Examiner raised an indefinite issue with respect to use of the word “placing”, and in fact, the Examiner suggested that the Applicant replace the word “placing” with the word “copying”. By reading this clause of Applicant’s claim in its entirety, it is clear that Applicant is defining how it places compared data items from data streams into a single output stream. To facilitate matters, Applicant has amended claim 1 to replace the word “placing” with the word “merging”. Support for this term can be found on Page 13, line 63 of the Specification. It is Applicant’s position that the amendment of this term is more precise and does not require the Examiner to perform an additional search since the terms are synonymous in the manner utilized by Applicant.

The Examiner has also raised an issue with the phrase “switching from processing a next data item”. To address this issue, Applicant has removed this clause from claims 1 and 6.

The Examiner has raised an issue with the term “formation” in claim 1, and has suggested that Applicant amend this term to “creating”. These are synonymous terms, and as such, to remove the Examiner’s concern Applicant has made the suggested amendment. Since these are synonymous terms, it is Applicant’s position that the amendment of this term does not require the Examiner to perform an additional search.

The Examiner has also raised an issue with the term “exclusive use” in claim 1 and has suggested that Applicant more specifically define this step in the process. Applicant has amended this term and replaced it with the term “copying”. Since Applicant’s claim pertains to merging data streams by placing/copying compared data items, it is Applicant’s position that this amendment does not require the Examiner to perform an additional search.

The Examiner has raised an issue with the phrase “a quantity of said input streams is an odd number greater than one” in claims 1, 6, and 9. In the preamble, Applicant uses the language “two or more” to define the quantity of input streams. The preamble concludes with the term “comprising”, which is open ended language. “The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” See MPEP §2111.03. As such, the body of the claim does not have to recite each of the three or more streams of data that are implied by the clause “an odd number greater than one”. However, to further clarify this point, Applicant has amended the preamble to recite “at least three input streams”.

The Examiner has also raised an issue with the term “a node”. Applicant has removed this language from claims 1 and 9, but has left this term in claim 6 as it would be inappropriate to remove it therefrom.

The Examiner has raised an issue with the term “merging” stating it is not consistent with the body of the claim. Applicant respectfully disagrees. The body of the claim pertains to merging of data from three or more input streams into a single output stream. The steps of the claim embody the process of merging the multiple input streams.

Applicant respectfully requests that the Examiner enter the amendments presented in claims 1, 6, and 9, and remove the rejection under 35 U.S.C. §112, second paragraph. None of the amendments presented herein raise new issues that would require further consideration and/or search.

## **II. Rejection of claims 1, 6, and 9 under 35 U.S.C. §102(b)**

In the Office Action dated March 31, 2006, the Examiner assigned to the application rejected claims 1, 6, and 9 under 35 U.S.C. §102(b) as being anticipated by *Smith*.

The remarks pertaining to *Smith* provided in the response to the prior Office Actions are hereby incorporated by reference.

As noted in the Response to the Second Office Action, *Smith* has a record index and compares a received record with records stored in the index. In response to the received record being a duplicate of a record already present in the index, the duplicate record is placed in a secondary list known as an exclusion list. As noted in Col. 8, lines 50-52 of *Smith*, in response to a duplicate item “the retrieved record is discarded and not processed.” Furthermore, as shown in both Figs. 3 and 4 of *Smith*, the process continues receiving records from an external source and comparing each received record with the records already present in the index. Accordingly, *Smith* teaches a process for comparing data records with a data record index and placing non-duplicate received records into the index.

In relation to a database, an index is defined as “a list of keys, each of which identifies a unique record”<sup>2</sup>. However, a data stream is defined as “a continuous flow of information or data”<sup>3</sup>. These two terms are not synonymous. A data stream pertains to the movement of data, while an index comprises data. The process of comparing data records with a data record index of *Smith* is not equivalent to comparing a data record with the output stream of Applicant. Applicant’s claims pertain to data streams that are compiled to form an output stream, not an index or data record, but rather a stream of data records. It is the output stream of the compiled data streams of Applicant that are later copied and compiled into a list, *i.e.* an index or database. Accordingly, Applicant’s claimed invention may be a precursor to the *Smith* patent in that it provides an improved method of merging multiple data streams into a single data stream that can then be fed into a list such as an index or alternative data storage system.

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<sup>2</sup>Webopedia, attached as Exhibit B.

<sup>3</sup>Dictionary.com, attached as Exhibit C.

Applicant's invention functions on a different principal than that taught in *Smith*. In fact, it is the very output stream of Applicant that may be used by *Smith* as the source of data records resulting in the need to formulate a method for replacing duplicate records with updated records. It is clear that *Smith* does not teach all of the elements as presented in Applicant's pending claims 1, 6, and 9. Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claims 1, 6, and 9, as amended.

### **III. Rejection of claims 1, 5, 6, 9, and 13 under 35 U.S.C. §102(a)**

In the Office Action dated March 31, 2006, the Examiner assigned to the application rejected claims 1, 5, 6, 9, and 13 under 35 U.S.C. §102(a) as being anticipated by Applicant's Admitted Prior Art (*AAPA*). As noted in the Response to the Second Office Action, the *AAPA* relates to merging two or more input data streams into a single sorted output stream. Pages 1 and 2 of Applicant's specification discuss the *AAPA*. As noted on these pages of the specification, the *AAPA* addresses forming a single output stream from multiple input streams. The *AAPA* also notes that there is only one known prior art solution for addressing duplicate data items discovered during the formation of the single output stream and that this solution only functions efficiently when "the number of input streams is an even power of 2". See page 2, last paragraph, through page 3, lines 1-5. Applicant has amended the independent claims to more specifically define Applicant's invention and how it functions when there are an odd number of input streams, *i.e.* an odd number of three or greater. The *AAPA* fails to illustrate an equitable solution for managing input streams containing duplicate data items in the manner claimed by Applicant when there is an odd number of three or more input streams. Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claims 1, 5, 6, 9, and 13.

#### **IV. Rejection of claims 2-4, 7, 8, 10-12, and 14 under 35 U.S.C. §103(a)**

In the Office Action dated March 31, 2006, the Examiner assigned to the application rejected claims 2-4, 7, 8, 10-12, and 14 under 35 U.S.C. §103(a) as being unpatentable over *Smith*, U.S. Patent No. 5,832,068, in view of *Applicant's Admitted Prior Art (AAPA)*.

The comments pertaining to *AAPA* and *Smith* in the Response to the prior Office Actions and above are hereby incorporated by reference.

There is no teaching in *AAPA* to process a next data item from a different input stream in response to a duplicate item present in the output stream when there are an odd number of input streams, with a minimum number of three or more input streams. As noted by the Examiner, the *AAPA* discusses any number of input streams. See Office Action, page 9. The Examiner refers Applicant to page 1 of the specification. However, this portion of the *AAPA* does not address resolution of duplicate key comparisons, as addressed by Applicant's claimed invention. On page 1 of the Specification, it elaborates that the swap between the data streams is omitted for duplicate key values. Furthermore, the *AAPA* elaborates that the swapping element does not functional properly for three or more input streams.

At most, *AAPA* teaches only three of the four status identifier values as claimed, and an algorithm responsive to the three identified values. The *Smith* patent teaches identifying duplicate records as between a data record being transmitted by way of a data stream and a data record stored within a database by comparing a single record at any one time to an index. See Fig. 3. However, whether considered individually or combined, the *AAPA* and *Smith* patent do not teach the four integer options associated with formation of an output stream as claimed by Applicant. "To establish a prima facie case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142, citing *In re*

*Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *AAPA* does not teach the four integer options as claimed by Applicant. In fact, at most *AAPA* may only be interpreted to include three of the four integer options. Similarly, *Smith* teaches the duplicate integer option, but does not teach the four options claimed by Applicant. Although it may be common practice in programming to assign value identifiers for specific tasks, as noted by the Examiner, it is the responsibility of the Examiner to produce analogous art that teaches the motivation to combine the prior art to produce the omitted limitation. “The rationale to support a rejection under 35 U.S.C. 103 may rely on logic and sound scientific principle. *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963). However, when an examiner relies on a scientific theory, evidentiary support for the existence and meaning of that theory must be provided. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979).” MPEP §2144.02.

Furthermore, Applicant contends that there is no motivation in the prior art references for combining *AAPA* and *Smith*. Rather, the motivation for such a combinations stems from the language in Applicant’s claims. *AAPA* teaches merging of two data streams, but does not address the merging process to accommodate three data streams, as claimed by Applicant. There is no teaching or suggestion in *AAPA* to be modified to accommodate the omitted limitations. To modify the teaching of *AAPA* to generate the fourth identifier would enhance the prior art to an element that was not contemplated at the time of the *AAPA*. Similarly, the suggested combination of *AAPA* and *Smith* would require a substantial reconstruction and redesign of the computer implemented instructions in *AAPA* for generating a status identifier in a manner not envisioned or contemplated by *Smith*. Accordingly, it is Applicant’s position that there is no motivation present in *AAPA*. to be modified in the manner as claimed by Applicant.

It is clear that the Examiner is taking the elements of Applicant’s pending claims and combining them in an improper manner. “It is impermissible to use the claimed invention as an instructions manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very

process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the references, since such a combination would go against the teaching of *AAPA*.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicants' specification. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is respectfully suggested that this rejection which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of *AAPA* and *Smith* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 2-4, 7, 8, 10-12, and 14 under 35 U.S.C. §103(a).

## **V. Conclusion**

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicant requests that the Examiner indicate allowability of claims 1-14, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Respectfully submitted,

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 or, v. com·piled, com·piling, com·piles

1. To gather into a single book.
2. To put together or compose from materials gathered from several sources: *compile an encyclopedia*.
3. Computer Science. To translate (a program) into machine language.

[Middle English *compilen*, from Old French *compiler*, probably from Latin *compilare*, to plunder : *com-*, *com-* + *pila*, heap (of stones), *pillar*.]

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### compiling

n : the act of compiling (as into a single book or file or list); "the job of compiling the inventory took several hours" [syn: compilation]



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## index

Last modified: Tuesday, July 28, 2003

(n.) In database design, a list of keys (or keywords), each of which identifies a unique record. Indices make it faster to find specific records and to sort records by the index field -- that is, the field used to identify each record.

(v.) To create an index for a database, or to find records using an index.

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## 2 entries found for *data stream*.

**Main Entry:** data stream<sup>1</sup>

**Part of Speech:** noun

**Definition:** a continuous flow of information or data; also written *datastream*

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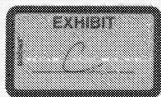
**Main Entry:** data stream<sup>2</sup>

**Part of Speech:** noun

**Definition:** a sequence of digitally encoded signals representing information when it is transmitted; also written *datastream*

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